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OFFICE OF PETITIONS

In re Application of	:	
KOLMYKOV-ZOTOV et al.	:	
Application No. 10/644,899	:	DECISION ON APPLICATION
Filed: August 21, 2003	:	FOR
Docket No. MSFT-6090/304449.01:	:	PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed December 10, 2008. Applicant requests that the determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from 229 days to 410 days.

The application for patent term adjustment is **DISMISSED**.

On September 10, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 229 days. On December 10, 2008, applicant timely submitted the instant application for patent term adjustment¹.

Applicant states that no terminal disclaimer has been filed in this application.

¹ The Office records show that the issue fee was received on December 10, 2008.

Applicant disputes the period of reduction of 5 days for the filing of a reply in response to the Notice to File Missing Parts of Nonprovisional Application (Notice to File Missing Parts) on December 22, 2003, as well as period of reduction of 287 days for the filing of an Information Disclosure Statement with a Supplementary European Search Report (IDS) on November 14, 2006.

Specifically, applicant asserts that a period of reduction of 35 days should be entered, instead of 5 days for the filing of the reply to the Notice to File Missing Parts. Applicant argues the period of reduction should be calculated as the number of days from the due date for the reply to the Notice to Filing Missing Parts (i.e. two-month period for reply from the mail date of the Notice to File Missing Parts), November 17, 2003, to the date the reply was filed, December 22, 2003. Similarly, applicant avers that a period of reduction of 67 days should be entered, instead of 287 days for the filing of the IDS, counting the number of days beginning on the September 7, 2006 due date for the IDS, and ending on November 14, 2006, the date the IDS was filed.

Applicant's arguments have been considered, but are without merit. The application history has been reviewed and it has been concluded that the determination of patent term adjustment under 35 U.S.C. 154(b) of 229 days is correct.

It appears that applicant has incorrectly evaluated the period of reduction for the filing of the reply to the Notice to File Missing Parts. Pursuant to 37 CFR 1.704(b):

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or

transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

(Emphasis added). That is, an applicant is subject to a reduction of patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b) if the applicant does not reply to the Office communication within three months regardless of the period for reply set in the Office action or notice.

In this instance, applicant did not file a reply to the Notice to File Missing Parts until December 22, 2003, three months and 5 days from the mail date of the Notice. Thus, applicant failed to engage in reasonable efforts to conclude processing or examination of this application. The period of adjustment was properly reduced by 5 days, counting the number of days in the period beginning on the day after the date that is three months after the date of mailing of the Notice to File Missing Parts, December 18, 2003, ending on the date the reply was filed, December 22, 2003. See 37 CFR 1.704(b). Accordingly, the period of reduction of 5 days will remain.

Additionally, applicant has incorrectly evaluated the period of reduction for the filing of the IDS with a Supplementary European Search Report on November 14, 2006. It is undisputed that after filing a response on February 9, 2006, applicant filed a supplemental reply or other paper in the form of the IDS on November 14, 2006. The record does not support a conclusion that the examiner expressly requested the IDS. Further, a review of the IDS, filed November 14, 2006, reveals that applicant did not include a proper statement under 37 CFR 1.704(d).¹ Thus, under the circumstances of this application, the submission of the supplemental reply or other paper on

¹ Pursuant to 37 CFR 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a

November 14, 2006, is a basis for reduction of patent term adjustment pursuant to 37 CFR 1.704(c)(8).

37 CFR 1.704(c)(8) states:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed[.]

In this instance, the period of adjustment was properly reduced by 278 days, counting the number of days beginning on the day after the date the initial reply was filed, February 10, 2006, and ending on the date that the IDS was filed, November 14, 2006. See 37 CFR 1.704(c)(8). Accordingly, the period of reduction of 278 days will remain.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance remains 229 days.

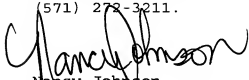
The Office will charge the \$200.00 fee set forth in 37 CFR 1.18(e) to the Deposit Account as authorized. No additional fees are required.

Applicant is reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicant approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 278-3211.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" being more prominent than the last name "Johnson".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions